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| 09/708,006      | 11/08/2000  | Akihiro Kishishita   | 197759US0CONT       | 1289             |

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EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 12/17/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# **Advisory Action**

**Application No.**

09/708,006

**Applicant(s)**

KISHISHITA ET AL.

**Examiner**

Paul A. Zucker

**Art Unit**

1621

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 19 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee), or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## **PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(d).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10/31/2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
 2. ☒ The proposed amendment(s) will not be entered because:  
 (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ they raise the issue of new matter (see Note below);  
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.  
 NOTE: \_\_\_\_\_.  
 3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-15

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
 10. ☐ Other: \_\_\_\_\_

*Handwritten signature: J. Zucker*  
 J. Zucker  
 Principal Examiner  
 Group 1600

Continuation of 5. does NOT place the application in condition for allowance because: The claimed crystalline forms and process for their production remain obvious over the prior art. The prior art (Wakamatsu) provides the process for production of material having Applicants' claimed advantages (See In re Grose and Flanigen 201 USPQ 57). This is provided in the context of aspartame which is a closely related analog to the instant neotame. Wakamatsu provides a teaching of the existence of a crystalline form of aspartame which has the instantly desired solubility properties as well as the process for producing it. The magnitude of the increase in solubility Applicants obtain (~ 2 fold) as shown in the instant specification (Page 9, line 21- page 10, line 20) is approximately equal to, or slightly less than, that expected based upon Wakamatsu's teaching (See column 3, lines 31-42, Table 1 and column 4, lines 1-16). Because of the close structural relationship of neotame and aspartame, one of ordinary skill in the art would have been clearly motivated to produce, by the prior art process, a crystalline form of neotame with the instantly desired solubility properties.

With regard to the rejection under 35 USC 102 (b), the Examiner points out that the difference of a single peak is insufficient to distinguish the instantly claimed crystalline form over that known in the prior art (See In re Grose and Flanigen 201 USPQ 57).

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